

**PRE-APPEAL BRIEF REQUEST FOR
REVIEW**

(filed with the Notice of Appeal)

Docket Number 042933/316979

Application Number 09/746,270

Filed December 20, 2000

First Named Inventor Michael Gargiulo

Art Unit 2152

Examiner Lee, Philip C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



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PATENT & TRADEMARK OFFICE ON OCTOBER 11, 2006.**

Attachment
Reasons for Requesting Pre-Appeal Brief Request For Review

I. Claims 11-30 are not unpatentable over Dusse

Claims 11-30, rejected under § 103(a) as being unpatentable over Dusse et al. (U.S. Patent No. 6,647,260, hereinafter “Dusse”) are directed to methods for downloading media content.

Independent claim 11 recites, *inter alia*, requesting media content from a mobile station, temporarily saving the media content within the mobile station, and previewing at least a portion of the media content on the mobile station. Applicants respectfully note initially, that the specific language of independent claim 11 indicates, by using the words “said media content” each time the media content is subsequently recited in independent claim 11, that the same media content that is requested is temporarily saved. In other words the claimed invention requires that the media content that was requested in the initial operation is temporarily saved within the mobile station. Additionally, at least a portion of the media content that was requested in the initial operation is also previewed on the mobile station. Applicants submit that Dusse fails to teach or suggest at least temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station as recited in independent claim 11.

The final Office Action alleges that the above-recited features are disclosed at col. 8, lines 35-47 of Dusse. Specifically, the final Office Action alleges that Dusse’s disclosure of terms, conditions and related information being pushed to the mobile station meets the above recited features. This analysis is respectfully traversed.

Applicants respectfully note that in response to Applicants previous arguments, the final Office Action states at page 10 that Dusse discloses the receipts of software modules and SMS messages containing terms, conditions and related information associated therewith. The final Office Action further states that both software modules and SMS messages are “media” content. Applicants initially challenge the assertion that a message merely containing terms, conditions and related information can fairly be considered media content as contemplated in the present application and as recited in the claimed invention. However, even if one assumes for the sake of argument that terms, conditions and related information can be considered media content (an assumption with which Applicants expressly disagree), Dusse still fails to teach or suggest

requesting media content from a mobile station, temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station as recited in independent claim 11, since the media content requested and that which is asserted to be temporarily stored and previewed are different media contents.

In this regard, Applicants respectfully note that, in any case, SMS messages containing terms, conditions and related information are not media content that was requested. It is clear from the disclosure of Dusse, that the only content of Dusse that could be argued to be analogous to the media content requested in the initial operation of independent claim 11 is the software modules. Dusse never provides any teaching or suggestion that the SMS messages containing terms, conditions and related information are requested. As such, in order to teach or suggest temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station as recited in independent claim 11, Dusse would need to disclose temporarily saving and previewing the software modules. However, Dusse fails to provide such disclosure and, furthermore, is not even asserted to provide such disclosure.

To the contrary, at best Dusse discloses that a first media content (namely the software modules) is requested, and then that some other and different content (namely the terms, conditions and related information (e.g., an SMS message)), which was not requested, is temporarily stored and previewed at the mobile station. However, this is not consistent with that which is recited in the claimed invention. Accordingly, Dusse fails to teach or suggest temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station as recited in independent claim 11.

Applicants also respectfully note that although the final Office Action states that “terms, conditions and related information are pushed to the mobile station, hence, temporarily stored until it is previewed and accepted, col. 8, lines 35-47”, there is no reason to believe that pushing information to a mobile station necessarily means such information is temporarily stored at the mobile station. Applicants submit that the Examiner is giving the reference credit for more than what it actually teaches. Accordingly, in addition to the arguments presented above, Applicants further assert that even if one assumes that the terms, conditions and related information are media content, Dusse still fails to teach or suggest temporarily saving the media content within the mobile station as recited in independent claim 11.

Finally, independent claim 11 also recites, *inter alia*, permanently saving the media content within the mobile station only when permission to save has been received. The final Office Action alleges that the above recited feature is disclosed by Dusse at col. 7, lines 32-40. However, the cited passage, and indeed all of Dusse, only discloses saving content relating to device features and services that match requested features or services and there is no indication whatsoever of any requirement of receiving permission to save the content as recited in independent claim 11. Accordingly, Dusse fails to teach or suggest permanently saving the media content within the mobile station only when permission to save has been received as recited in independent claim 11.

Independent claim 16 contains similar recitations to those of independent claim 11 with respect to requesting media content from a mobile station and temporarily saving the media content within the mobile station and permanently saving the media content within the mobile station only when permission to save has been received except that the media content is more specifically recited as being a ring tune deck. Accordingly, Dusse has the corresponding same deficiencies with respect to independent claim 16 as those noted above with respect to independent claim 11. Thus, independent claim 16 is patentable for at least those reasons given above for independent claim 11.

Thus, independent claims 11 and 16 are neither anticipated nor rendered obvious in view of Dusse. Claims 12-15 and 17-30 depend directly or indirectly from independent claims 11 and 16, respectively, and thus include all the recitations of their respective independent claims. Therefore, dependent claims 12-15 and 17-30 are patentable for at least the reasons given above for independent claims 11 and 16.

Accordingly, for all the reasons stated above, Applicants respectfully submit that the rejections of claims 11-30 over Dusse should be reversed.

II. Claims 11 and 16 are not obvious in view of the Vazvan and Ronen

Claims 11 and 16 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over Vazvan (WO 00/36857) in view of Ronen et al. (U.S. Patent No. 5,905,736, hereinafter "Ronen").

Independent claims 11 and 16 recite, *inter alia*, permanently saving media content (claim 11) or a ring tune file (claim 16) within the mobile station only when permission to save has been received.

As admitted in the Office Action, Vazvan fails to teach or suggest the above recited feature. Accordingly, the final Office Action cites Ronen as curing the deficiency of Vazvan. Specifically, the final Office Action asserts that Vazvan discloses permanently saving media content within a mobile station, but not permanently saving only when permission to save has been received. The final Office Action then states that “Ronen teaches permanently saving when a permission from a billing mechanism has been received from a user (col. 7, lines 30-60)”. However, Ronen merely permits continuance of a transaction in response to a notification that a billing mechanism has been established (col. 7, lines 46-49) and does not disclose permission to save anything, much less permission to save media content. In fact, the only information permanently saved according to Ronen is information regarding the billing mechanism which is saved at the billing server. However, even this information is not stored only when permission to save has been received.

In fact, Applicants respectfully note that Vazvan teaches away from permanently saving the media content (claim 11) or ring tune file (claim 16) within the mobile station only when permission to save has been received as claimed in independent claims 11 and 16, respectively, since Vazvan is directed to enabling the sharing of musical tune messages between subscribers as described from page 2, line 30 to page 3, line 2 and page 3, lines 10-17. In these passages, Vazvan discloses as objects of the invention the provision of ring tones to a terminal device with the possibility of transmitting such ring tones to other third party devices. Thus, the requirement of permission to save would be contrary to the object of Vazvan. Accordingly, particularly in light of Vazvan’s teaching away, there would be no motivation to combine a reference which does not save content only when permission to save has been received with another reference which discloses continuance of a transaction when permission is received in order to arrive at the claimed invention.

Since neither Vazvan nor Ronen teaches or suggests permanently saving the media content (claim 11) or ring tune file (claim 16) within the mobile station only when permission to save has been received as claimed in independent claims 11 and 16, respectively, any combination of the cited references likewise fails to render independent claims 11 and 16 obvious for at least the same reasons described above. Thus, independent claims 11 and 16 are patentable over the cited references.

Accordingly, for all the reasons stated above, Applicant respectfully requests reversal of the rejections of claims 11 and 16 in view of the combination of Vazvan and Ronen.